

REMARKS

This application includes pending claims 80-86, 89-98, 101-110 and 113-115.

On April 7, 2006, Mr Zibelli conducted a telephone interview with Examiner Zurita and Examiner Fadock. During that interview, Mr Zibelli argued the points set forth below, including the improper indication of a priority date, the double patenting rejection, the 112 rejection and the 103 rejection, in the same manner as set forth below. It was indicated that the application would be reviewed and a subsequent interview, on April 8, 2006 was conducted.

During the April 8 interview, Examiner Fadock indicated that the 112 and 103 rejections would be withdrawn, that an indication of a filing date the application would be accorded would be indicated in a subsequent office action, with different reasons than previously asserted, and that a new art rejection may be presented. Mr. Zibelli indicated that he would review any assertion of the application not being entitled to the parent application filing date after seeing the new reasons, and that a traversal would be filed if appropriate.

The Office Action indicates that the Examiner has requested the Applicant to identify where in the prior applications the features of the present invention are first disclosed, and gives an example that in the priority document, the Applicant does not mention data subject and data recipient. The parent application supports the terms data subject and data recipient, as may clearly be seen with reference to the drawings and specification of the parent application.

The Office Action then asserts that claims addressed to these entities are accorded the filing date of the instant application, April 27, 2000. The Examiner further requests that Applicant identify which inventor(s) contributed which features claimed in the present application that were also present in one or more prior application with different inventors.

It is respectfully asserted that the Examiner has improperly asserted that the present application is entitled to only the filing date of the present application. As indicated in MPEP

201.08, unless the filing date of an earlier application is actually needed to overcome a reference, there is no need for the office to make a determination as to whether the earlier application discloses the invention in a continuation-in-part situation. The MPEP indicates that an alleged continuation-in-part application should be allowed to claim the benefit of the earlier application if there is a common inventor, the applications were co-pending and the continuation-in-part application contains a reference to the earlier filed application. These requirements have been met, and the Peckover and Walker references asserted against the claims do not have effective dates that raise an issue as to whether the filing date of the parent application is needed.

Further, even if the references were intervening references, before concluding claims of the present application are not entitled to the filing date of the parent application, the Examiner would have to make a finding that the claims of the application are not supported by the specification of the parent application. Moreover, as indicated in the MPEP, the present situation does not make such a determination necessary. It is asserted that it is improper for the Examiner to require Applicants to point out support in the parent application for certain claimed features when there is no intervening reference being applied, and applicants request that the Examiner withdraw the unsupported statement that the claims are only entitled to the April 27, 2000 filing date. It is also asserted that it is improper for the Examiner to further request that Applicant identify which inventor(s) contributed which features claimed in the present application that were also present in one or more prior application with different inventors. Applicants will address any new assertion of according an effective filing date after seeing the new office action as explained above.

The Office Action provisionally rejects claims 80, 92 and 104 under the judicially created doctrine of obviousness-type double patenting over claims 38-57 of copending application 09/752,795. This rejection is respectfully traversed.

The claims of the '795 application do not recite many features recited in the independent claims of the present application, including determining whether the data subject is registered; determining whether the data recipient is authorized; if the data subject is registered and the data

recipient is authorized, retrieving purchasing information associated with the data subject from a database in the data repository computer; sending a purchase query to the data subject network communication device; and in response to a purchase reply received from the data subject network communication device, sending purchase transaction information to the data recipient. The Examiner makes the general allegation that it would have been obvious to combine 09/572,795 with general knowledge to come up with all the features of claim 80. As stated in MPEP 804, any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims. The Examiner has not noted all of the differences in the claims, much less how the differences would have been obvious. Accordingly, the rejection is improper and should be withdrawn.

The Office Action rejects claims 80, 92 and 104 under 35 USC 112, second paragraph. This rejection is respectfully traversed.

Regarding the term “offer”, the specification at page 12, for example, discusses items that may be included in an offer in the context of a computer transaction, as referenced in the office action. The Examiner’s reference to a dictionary is inappropriate, as such a dictionary definition is general, and not in the context of a computer transaction. Further, the Federal Circuit sitting en banc in Edward H. Phillips v. AWH Corp., 03-1269, -1286 (Fed. Cir., July 2005) has cautioned against the improper use of dictionaries, and refers to the improper use of general dictionaries. The court emphasizes the importance of the specification in interpreting the claims.

Further, the Examiner incorrectly refers to Applicants “new definition” being different from the terms definition in the specification, specifically referring to the Applicants statement that:

“The offer as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party).”

This is certainly not a definition of the recited term “offer” as asserted by the Examiner, but is instead merely pointing out that the other recitations around the term “offer” in claim 80 of “an offer associated with the data recipient and a message including a network communication

device software identifier” require the offer to be (1) received from a data subject (amended to recite a data subject network communication device) and (2) associated with a data recipient (a second party), require more than just an offer.

The Office Action also indicates that the term “purchase transaction information” is indefinite. It is asserted that this term should be interpreted in view of its ordinary meaning as information about a purchase transaction. Withdrawal of the rejection is requested.

The Office Action rejects claims 80-115 under 35 U.S.C. 103(a) over Peckover (U.S. Patent 5,119,101) in view of Walker (U.S. Patent 5,794,207). This rejection is respectfully traversed.

Independent claims 80, 92 and 104 recite a method, system or machine-readable medium for facilitating transactions over a computer network that includes receiving, from a data subject network communication device, an offer associated with a data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer. These claims are allowable over the prior art for at least the following reasons.

Neither Peckover nor Walker disclose or suggest includes receiving, from a data subject network communication device, an offer associated with a data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer. The Office Action asserts that Peckover discloses receiving from a customer an offer associated with a merchant. The Office Action does not assert where Peckover allegedly discloses this feature. The Examiner is apparently asserting that in Peckover an offer is received from a consumer, where the offer was created by a merchant. Applicants do not believe that Peckover contains any such disclosure.

The Examiner further asserts that “Customers receive advertisements (applicants offer associated with a data recipient) at PC’s (applicants network communication device), as in Fig.

2, item 22. Customers review, and accept or decline the offers, using web browser software (applicant's network communications software)." However, Peckover does not disclose that a customer can accept an offer, and that the offer is sent from the customer to the server.

In fact, Applicants do not see any disclosure in Peckover where a user accepts an offer from a merchant, much less where the offer is sent from the customer to a data repository computer. The Examiner refers to Figs. 40-42 of Peckover. Figure 40 illustrates a Web page allowing a user to search for products. Figure 41 illustrates a Web page used to specify search criteria. Figure 42 illustrates a web page used to compose an advertisement for a television set. None of these Figures appear to disclose any features allowing a user to accept an offer from a merchant, much less where the offer is sent from the customer to a data repository computer.

The Examiner further refers to the use of cookies, referring to col. 6, lines 26-32. Applicants fail to understand how the disclosure of the use of cookies somehow supports receiving from a customer's PC an offer associated with a merchant. The disclosure referred to by the Examiner is in the Background section of Peckover describing disadvantages, from a consumers point of view of today's electronic commerce, mentioning how consumer searching is not private, and that Web sites may use cookies to gather information about the searching consumer. It is asserted that this is not a disclosure of receiving, from a data subject network communication device, an offer associated with a data recipient as required by the claims.

Peckover discloses a system for electronic commerce having personal agents that represent consumers and providers in a "virtual marketplace." Peckover's system collects market information related to consumer demand while protecting the identity of consumers and maintaining their privacy. *See*, Abstract; Summary of the Invention (Col. 14, line 15 to line 53). A major use of this system is "... to assist a consumer in locating information about a product that is advertised for sale. It need not be possible for the consumer to carry out the actual purchase within Agent System 10; it is only necessary that products be advertised within the system. However, when secure electronic transactions are available, it is anticipated that consumers will make actual purchases through the system" (emphasis added). *See*, Peckover at

Col. 27, Lines 52–65. “It is also anticipated that, in the future, the system will further comprise actual purchase transactions.” *See*, Peckover at Col. 38, Lines 63–64.

Thus, Peckover discloses a system which assists users in locating products for sale, but only anticipates that the sale may actually be consummated at some point in time in the future, i.e., “when secure electronic transactions are available.” Other than this suggestion, Peckover is entirely silent on whether his system may actually be used to purchase items over a network. More particularly, Peckover fails to teach or suggest receiving, from a data subject network communication device, an offer associated with a data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer.

In Applicants claims, the offer is sent from the data subject network communication device and received by the data repository computer, where the offer is associated with the data recipient. The Office Action asserts that in Peckover, the offer is associated with a merchant (because it was created by the merchant), and that this offer created by the merchant is received from a customer. Peckover does not appear to disclose such an offer created by a merchant is received from a customer. Because Peckover is missing this feature, and because Walker does not remedy this deficiency, none of the pending claims are obvious over the cited references.

None of the three portions, or any other portions, of the references disclose or suggest the features of the independent claims. For at least these reasons, claims 80, 92 and 104 are allowable, as are all dependent claims. Withdrawal of the rejection is requested.

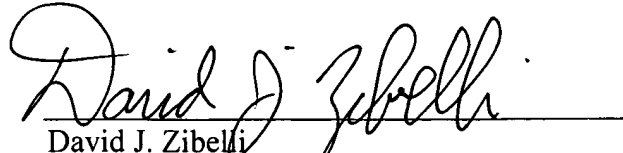
Because the prior art fails to teach the claimed limitations, a prima facie case of obviousness has not been established. Withdrawal of the rejection is requested.

The Office is authorized to charge any fees due under 37 C.F.R. §§ 1.16, 1.17 or 1.136 to deposit account 11-0600. In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance.

Should the Examiner have any questions concerning this matter, he is invited to contact Applicants' undersigned attorney at 202/220-4334.

Respectfully submitted,

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